UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,522	02/14/2002	Susanne H. Goodson	SPG6594PDUS	6712

27624 7590 01/06/2009

AKZO NOBEL INC.
LEGAL & IP
120 WHITE PLAINS ROAD, SUITE 300
TARRYTOWN, NY 10591

EXAMINER	
SHEIKH, HUMERA N	

ART UNIT	PAPER NUMBER
1615	

MAIL DATE	DELIVERY MODE
01/06/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/074,522	GOODSON ET AL.	
	Examiner	Art Unit	
	Humera N. Sheikh	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 2 and 4-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

Receipt of the Response after Non-Final Office Action and Applicant's Arguments/Remarks, all filed 10/16/08 is acknowledged.

Claims 1, 2 and 4-10 are pending in this action. Claim 1 has been amended. Claims 3 and 11-21 have previously been cancelled. Claims 1, 2 and 4-10 remain rejected.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2 and 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pardini (U.S. Patent No. 4,708,870).

Pardini ('870) teaches a method for imparting a non-fugitive antimicrobial activity to an article of manufacture, which comprises forming the articles of manufacture from an acrylonitrile composition which includes up to 10% of a protonated amine. The antimicrobial activity is inherent in the acrylonitrile composition (see Abstract).

Pardini teaches that non-fugitive antimicrobial activity is imparted to acrylic polymers, fibers or fabrics made thereof, by copolymerization of an acrylic protonated amine comonomer and/or by use of protonated amine end groups (col. 2, lines 1-63).

The Examples at column 5 demonstrate various embodiments of the invention. Example 1 at Table II on column 5 demonstrates acrylonitrile (AN) and methacrylate (MA) monomers were copolymerized with various protonated amine-containing monomers. The example shows that the copolymerization of protonated amine containing monomers in acrylic polymers imparts antimicrobial activity.

With regard to mole percent claimed by Applicant, one of ordinary skill in the art would be able to make the conversion between mole percent and percent by weight. No unexpected results have been observed through Applicant's claimed mole percent since the prior art clearly teaches similar mole percents, as shown in the Examples.

While Pardini is silent about polymer film thickness (of 1 to 5 mil), it is the position of the Examiner that the film thickness now claimed does not patentably distinguish over Pardini as no unexpected result has been attributed to the film thickness claimed herein. The prior art amply teaches an article of manufacture that provides for antimicrobial activity and one that employs the same components, *i.e.*, protonated amine, as that desired by Applicants. Moreover, the determination of a suitable or effective film thickness could be determined by one of ordinary skill in the art based on routine or manipulative experimentation to obtain optimal results as these are variable parameters.

Given the teachings of Pardini discussed above, the instant invention, when taken as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's arguments filed 10/16/08 have been fully considered but were not found persuasive.

Rejection of claims 1, 2 and 4-10 under 35 U.S.C. §103(a) over Pardini (4,708,870):

Applicant argued, "Pardini teaches a method for imparting non-fugitive antimicrobial activity to an article of manufacturing by forming the articles of manufacture from an acrylonitrile composition that includes up to 10% of a protonated amine (Abstract). The antimicrobial activity is inherent in the acrylonitrile composition (Abstract). The maximum amount of protonate amine taught by Pardini is 3 mole %. Pardini specifically limits the amount of protonated amine to no more than 10%, or 3 mole %, in order to achieve the antimicrobial activity. Therefore, Pardini provides no motivation to one skilled in the art to seek compositions having from 5 to 40 mole percent of protonated amine monomer units."

Applicant's arguments have been considered, but were not found persuasive. Applicant's specification, page 4, line 20 indicates as working embodiments that from 2% is within the scope of the invention. Hence it cannot be seen how the prior art 3% would be so distinguishing from the limitations desired as to impart an unexpected result. Note that the spec. at page 4 suggests 5% as simply a preferred amount. Finally note that the % may be established by the use of a mixture of monomers.

Applicant argued, "Pardini makes absolutely no reference to film coatings useful for coating, for example, laundry detergent tablets. Pardini teaches spinning its polymer into fiber or yarn. Pardini does not teach or suggest its polymer being triggerably soluble in water based

upon changes in pH, salt or surfactant concentration or both. Rather, Pardini only suggests that its polymer is soluble in organic solvent (col. 3, lines 65-66)."

These arguments have been considered, but were not found persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., film coatings useful for coating) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, the polymer 'film' of the invention does not distinguish from the prior art's teaching of articles of manufacture, which employs the same ingredients (such as protonated amines) in amounts admitted to be effective. With regards to percentage of protonated amines, burden would be shifted to Applicant to establish that the 3% of the prior art would not be effective nor capable of having the desired property, i.e., controlled release.

While Pardini is silent about polymer film thickness (of 1 to 5 mil), it is the position of the Examiner that the film thickness now claimed does not patentably distinguish over Pardini as no unexpected result has been attributed to the film thickness claimed herein. The prior art amply teaches an article of manufacture that provides for antimicrobial activity and one that employs the same components, *i.e.*, protonated amine, as that desired by Applicants.

The 103(a) obviousness rejection has been maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

--No claims are allowed at this time.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday during regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Humera N. Sheikh/

Primary Examiner, Art Unit 1615

hns

January 05, 2009